

Applicant : Cheol Kim  
Serial No. : 09/254,058  
Page No. : 7

REMARKS

Applicant respectfully requests reconsideration of the application identified above. Claims 6-15, 32-33, 35 and 51 are pending in the application, and claims 6, 32 and 51 (all of the independent claims) are amended. Applicant respectfully traverses the rejections as conceivably applied to the pending claims.

Applicant wishes to express appreciation to Examiner Christman for the courtesies extended to Applicant's attorney in the personal interview on June 26, 2003, during which claims 6, 32 and 51 were discussed in view of U.S. Patents 5,572,260 to Onishi; 5,659,368 to Landis; 5,833,468 to Guy; and 5,295,836 to Ryu. Examiner Christman agreed that in the amended claims, which recite that the language learning data is pre-recorded and available over the Internet, is different from (1) the live broadcast system of Guy; (2) the pre-recorded VHS tapes of Onishi; and (3) Landis, which provides information enabling a user to select a television program to record with a VCR. The examiner recommended that the Applicant limit the "'communication network' to a web-based network or similar language". Accordingly, the claims are amended to recite that the communication network is the Internet or is Internet-based. Support for this amendment is found at Pg. 3, Lns. 15-23.

Finally, Examiner Christman requested the submission of arguments to further support (1) the non-combinability of Onishi and Guy, Onishi and Landis, and Onishi and Ryu, and (2) the patentability of the amended claims over these references.

Applicant : Cheol Kim  
Serial No. : 09/254,058  
Page No. : 8

I. Art Rejection Based on Onishi in view of Landis

As originally presented, claims 6-15, 32-33, 35 and 51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Onishi in view of Landis.

Onishi is directed to a language learning system. The pre-recorded Onishi videotapes are played by a VCR 100 to produce audio and video signals. The language decoder 200 receives the signals, then extracts the closed caption data from the video signal and displays closed caption subtitles on the monitor 120. Col. 4, Lns. 30-44. Onishi is specifically directed to a problem with videotape play: when a tape pause function is terminated, the closed caption subtitles are not displayed until a few moments after the tape begins to play. Col. 2, Lns. 23-28. To address this problem, the Onishi decoder controls the VCR to rewind the videotape just before the pause function is terminated, so that the closed caption control codes are operational and display the closed caption subtitles as soon as play begins. Col. 3, Lns. 16-29.

Landis discloses a system that decodes extended data services (EDS) signals embedded in television signal transmissions. The EDS signals include program identifiers, such as program broadcast time, date and receiver channel number, as well as the duration, title and content of programs. Col. 2, Lns. 36-44; Col. 8, Lns. 33-35. A user can program a VCR to record a particular program by specifying EDS programming information. Col. 2, Lns. 46-51.

Applicant respectfully submits that Onishi and Landis are not properly combinable because there is no motivation or reasonable expectation of success for the combination. The motivation to make the Applicant's claimed invention *and* a reasonable expectation of success must *both* be found in the prior art, *not* in hindsight of the Applicant's disclosure. *In re Vaeck*, 947 F.2d

Applicant : Cheol Kim  
Serial No. : 09/254,058  
Page No. : 9

488; 220 U.S.P.Q.2d 1483 (Fed. Cir. 1991); M.P.E.P. §2143. Here, Onishi relies exclusively on closed caption data stored on pre-recorded videotapes to teach a language, whereas Landis is completely oblivious to closed caption data, and in fact, has no use for the closed caption data. Instead, Landis relies on transmitted EDS signals to passively detect and display programming information. Moreover, Onishi and Landis have unrelated objectives--*playing* a pre-recorded videotape to display closed caption text versus *recording* a program on a videotape based on passively detected EDS signals--which precludes any motivation for their combination.

Additionally, Applicant respectfully submits that with regard to amended independent claims 6, 32 and 51, Onishi and Landis fail to disclose, teach or suggest (1) an input means for identifying selected, pre-recorded language learning data from an Internet-based network, or (2) an interface means for receiving the identified language learning data from the Internet-based network. Instead, Landis, which is relied upon for its disclosure of a network, merely discloses the *passive reception* of signals transmitted over a *television* network to activate a VCR and to record a program.

## II. Art Rejection Based on Onishi in View of Guy

As previously presented, claims 6-15, 32-33, 35 and 51 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Onishi in view of Guy.

Guy is directed to a virtual classroom presentation that is broadcast live. A camera records an instructor's presentation. The instructor and students may "write" on an electronic chalkboard. Presentation data (i.e., images of the instructor) and display data (i.e., the text written on the chalkboard) are merged into a television signal, which is transmitted to students' PCs, is

Applicant : Cheol Kim  
Serial No. : 09/254,058  
Page No. : 10

converted, and is displayed as an image of the classroom on one part of the screen, and as text on another part of the screen. Col. 4, Lns. 40-60.

Applicant respectfully submits that Onishi and Guy are not properly combinable because there is no motivation or reasonable expectation of success for the combination. Specifically, Guy emphasizes *live and interactive* instruction over a television network (complete with an interactive chalkboard), whereas in contrast, Onishi emphasizes *non-interactive* instruction that enables a user to learn at her or his own pace. In fact, the learning methods of the references are so incompatible that Guy specifically teaches away from videotape instruction (like that in Onishi) because it is difficult to distribute pre-recorded videotapes to each of the students before conducting a lecture. Col. 1, Lns. 28-46. Therefore, there would be no motivation to combine the two very different learning systems of Onishi and Guy.

Furthermore, with regard to amended independent claims 6, 32 and 51, Applicant respectfully submits that even if hypothetically combined, Onishi and Guy fail to disclose, teach or suggest (1) input means for identifying pre-recorded language learning data over an Internet-based network, or (2) interface means for retrieving the pre-recorded language learning data from the Internet-based network. Indeed, the references do not even hint at the requirements of an Internet-based communication network language learning system, let alone comprehend what would be required to identify and receive pre-recorded language learning data from such a network.

### III. Potential Rejection Based on Onishi in view of Ryu

During the interview, Examiner Christman requested the Applicant's attorney also to address proactively a possible rejection under 35 U.S.C. §103(a) based on Onishi in view of Ryu.

Applicant : Cheol Kim  
Serial No. : 09/254,058  
Page No. : 11

Ryu discloses a remote lecturing system. As shown in Figs. 1 and 2, the system includes a center station 10 coupled via a network to terminal stations 40, 50 and 60. From a terminal station 40, a student selects a specific lecture from the center station 10. The data management part 21 of the center station 10 retrieves the selected lecture from first storage 12a and transmits the requested lecture to the student at the terminal station as indicated by arrow A2 in Fig. 2. Col. 6, Lns. 16-22. As the lecture is being transmitted, the student may transmit a question from the terminal station 40 to the center station 10 as indicated by arrow A3 in Fig. 2. Col. 6, Lns. 23-33. The data management part selects an answer from the data storage 12b and transmits the answer to the student as indicated by arrow A4.

Applicant respectfully submits that Onishi and Ryu are not combinable because there is no motivation or reasonable expectation of success for the combination. First, the purpose of Ryu is to play pre-recorded lectures for students. There is no suggestion in the references that the Ryu lectures require the closed caption text display of Onishi to assist a student in reviewing the lecture. Indeed, assuming the Ryu lecture is conventional--i.e., the instructor uses an overhead or chalkboard--there is no need to superimpose closed caption text on the student's terminal station at all because necessary text information would be displayed in the images of the overhead or the chalkboard. Therefore, the closed caption signal extraction and decoding of Onishi are entirely unnecessary in the Ryu lectures, and as such, there would be no motivation for the combination of this Onishi feature with Ryu to arrive at the invention of the amended claims.

Second, Ryu identifies the pre-recorded videotapes of Onishi as inferior learning systems because students cannot obtain answers to questions as they review the lecture. Col. 1, Lns.

Applicant : Cheol Kim  
Serial No. : 09/254,058  
Page No. : 12

40-47. Thus, videotape lectures, like those of Onishi, are precisely the learning devices that Ryu was designed to replace. As a result, Applicant respectfully submits that there is no motivation to combine the inferior learning system of Onishi with the new system of Ryu.

Third, Applicant believes that the fundamental memory storage devices of Onishi and Ryu are completely incompatible with one another; and neither reference suggests a way to overcome this incompatibility, let alone to arrive at the invention as defined in the amended claims. For example, replacing the magnetic disk unit of Ryu with the videotape of Onishi would eliminate the interactive question-asking/answer-providing feature of Ryu because there would be no way for students to input questions onto the videotape. Likewise, incorporating the magnetic disk storage of Ryu into Onishi would render superfluous the purpose of Onishi--to rewind a *videotape* and display closed caption information immediately after a videotape pause is terminated.

Fourth, the references in no way provide any motivation for encoding the Ryu lectures with closed caption signals. In fact, nothing in Ryu suggests that the Ryu system is even compatible with the closed caption signals, let alone how closed caption signals would be decoded by the terminal stations or other components of the system. Therefore, other than in impermissible hindsight of Applicant's disclosure, Applicant believes that there is no motivation to combine the closed caption signal extraction capability of Onishi with the lectures stored on the closed network of Ryu.

Furthermore, with regard to amended claims 6, 32 and 51, Applicant respectfully submits that even if Onishi and Ryu were hypothetically combined, these references fail to disclose, teach or suggest an interface means in communication with an external Internet-based

Applicant : Cheol Kim  
Serial No. : 09/254,058  
Page No. : 13

communication network. The only network disclosed in either reference is the Ryu network, which appears to be a closed network that is in no way associated with the Internet. For example, in Fig. 2, the Ryu network 30 is in communication with *only* the center station 10 and the student or lecturer terminal stations 40, 50 and 60. Ryu conspicuously fails to show or even mention an external network, e.g., an Internet-based network with which his system is compatible. Applicant believes that the identification of the students' computers as "terminal stations" indicates that the learning terminals are dedicated computer stations at fixed locations in an institution (such as a university) where a student must go to "attend" the lecture of Ryu. The disclosure of such specific network-dedicated computer stations without the disclosure of other "PCs" indicates that the Ryu network is closed and/or not connected to the Internet.

Therefore, Applicant respectfully submits that the pending claims are patentable over Onishi and/or Ryu.

#### IV. Dependent Claims

Claims 7-15, 33 and 35 depend from claims 6 and 32, respectively, and are allowable over the applied references for the reasons noted above in connection with those claims. Further, these claims recite additional subject matter. Dependent claims 7 and 33 recite a caption data component and an audio data component that are synchronously outputted to the display. Dependent claim 8 recites a subdividing mark number and a second memory means that stores caption data addresses. Dependent claim 9 recites a digital signal processor and a microprocessor means. Dependent claim 10 recites that the audio data is converted to analog audio signals. Dependent claim 11 defines an amplifier that amplifies the analog audio signals. Dependent claim 12 defines a

Applicant : Cheol Kim  
Serial No. : 09/254,058  
Page No. : 14

microprocessor means that reads mark numbers and outputs next or previous mark numbers to a DSP means to play next or previous caption and audio data components. Dependent claim 13 recites a microprocessor means operable in first and second logic states. Claim 14 recites that the first memory means is a flash memory and the second memory is a random access memory. Dependent claims 15 and 35 recite that the first memory is an external memory module.

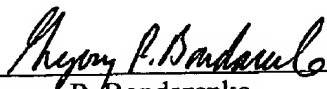
#### CONCLUSION

In view of the above amendments and these remarks, it is respectfully submitted that the application is in condition for allowance. A notice to that effect is earnestly and respectfully solicited.

Respectfully submitted,

CHEOL KIM

By: Warner Norcross & Judd LLP

  
\_\_\_\_\_  
Gregory P. Bondarenko  
Registration No. 44,547  
900 Fifth Third Center  
111 Lyon Street, N.W.  
Grand Rapids, MI 49503-2487  
(616) 752-2420

/alg  
70591.70591-001  
891407-2